

REMARKS/ARGUMENTS

Claims 1-54 are pending and at issue in the present application.

In response to the examiner's request for information under 37 C.F.R. § 105, applicants respectfully call the examiner's attention to the specification of U.S. Patent No. 6,327,599 (hereinafter "the '599 patent") incorporated by reference in the present application. Specifically, applicants refer to column 7, lines 36-49 of the '599 patent, wherein applicants state that:

It should be noted that the present invention is not limited to production of books of the same "version" (i.e., books having the same master information). For example, the book versions of FIGS. 7a, 7b and 8a, 8b may be produced together with the book version of FIG. 6a and 6b in the same production run or job. The book version example of FIGS. 7a and 7b includes pages P5-P8 to be reproduced a number of times to produce individual books. The book version of FIGS. 7a and 7b is identical to of the book version of FIGS. 6a and 6b except that an additional area 113 is provided on the page P5 for placement of variable information, in addition to the areas 110 and 112. Because of the addition of the area 113, the remaining master information appearing in an area 114 differs from master information appearing in an area 116 of the page P1 of FIG. 6a.

Referring to Figs. 6-8 of the '599 patent, it should be noted that the demand printer is capable of printing customized content on at least a portion of at least one of the pages without limitation as to position and orientation of the customized content over an entire surface of at least one page.

Further, applicants traverse the rejection of claims 1-54 as failing to comply with the written description requirement. In response to the examiner's contention that there is no support for the claim limitation "without limitation as to position and orientation of the customized content over an entire surface of the at least one page," please refer to the language from the '599 patent quoted above.

Applicants traverse the rejections of various claims at issue as anticipated by Dooley, Graushar, or Weller or as obvious over varying combinations of such patents and Warmus et al.

Claim 1, and claims 2-22 dependent thereon, recite book production apparatus including a gathering line operable during a single, continuous production sequence and a demand printer operable during a single production sequence for producing first and second different printed pages in response to print commands issued during the production sequence. The demand printer prints customized content on at least a portion of at least one of the pages without limitation as to

position and orientation of the customized content over an entire surface of the at least one page. A feeding device is operable to feed the printed pages to the gathering line and a controller coordinates simultaneous issuance of the print command to the demand printer and operation of the gathering line, the demand printer, and the feeding device during a single production sequence to produce books.

Claim 23, and claims 24-35 and 43-48 dependent thereon, specify print production apparatus including a gathering line operable during a production sequence and a demand printer for producing first and second pages each having customized content that is disposed in an orientation at a position on a surface thereof. The first and second pages are printed during a time interval during which the gathering line is continuously moving. The demand printer includes means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page. A feeding device is operable to feed the customized pages to the gathering line and a controller coordinates operation of the gathering line, the demand printer, and the feeding device during the production sequence to produce customized books.

Claims 36-42 and 49-54 recite a method of producing books including the steps of supplying a gathering line and a demand printer for producing first and second pages at least one of which has customized content printed on at least a portion thereof without limitation as to position and orientation of the customized content over an entire surface of the at least one page in response to print commands generated during a continuous production sequence. The method also includes the steps of supplying a feeding device and coordinating simultaneous operation of the gathering line, the demand printer, and the feeding device during a production sequence to produce the books.

None of the art cited by the examiner discloses or suggests a book production apparatus including a demand printer operable during the single production sequence to produce different printed pages in response to print commands issued during a single continuous production sequence, wherein the demand printer prints customized content on at least a portion of at least one of the pages without limitation as to position and orientation of the customized content over an entire surface of the at least one page together with a controller that coordinates simultaneous issuance of the print commands to the demand printer and operation of a gathering line, the

demand printer, and a feeding device during the single production sequence, as recited by claims 1-22.

Further, none of the prior art cited by the examiner discloses or suggests a book production apparatus including a demand printer for producing first and second different pages each having customized content that is disposed in an orientation at a position on a surface thereof, wherein the first and second pages are printed during a time interval during which a gathering line is continuously moving and wherein the demand printer includes means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page together with a controller that coordinates operation of the gathering line, the demand printer, and a feeding device during a production sequence to produce customized books, as recited by claims 23-35 and 43-48.

Still further, none of the art cited by the examiner discloses or suggests a method of producing books including the step of supplying a demand printer for producing first and second pages wherein at least one of the pages has customized content printed on at least a portion thereof without limitation as to position and orientation of the customized content over an entire surface of the at least one page together with the step of coordinating simultaneous operation of a gathering line, the demand printer, and a feeding device during a production sequence to produce books. These steps are recited by claims 36-42 and 49-54.

In fact, each of Dooley, Graushar, and Weller discloses the use of customization printers that are fixed in position during a print job. While these customization printers may be movable (i.e., repositionable) between print jobs, it is clearly the case that each of these customization printers is capable of printing in only a selected position and orientation during a particular print job, and none of these customization printers is capable of printing without limitation as to position and orientation of customized content over an entire surface of a printed page in response to print commands issued or generated during a production sequence. Warmus et al. discloses controlling an electronic press to print fixed and variable information. However, Warmus et al. does not teach coordinating the simultaneous operation of a gathering line, a demand printer that is capable of printing without limitation as to position and orientation of customized content over an entire surface of a page, and a feeding device during a production sequence.


Because none of Dooley, Graushar, Weller, or Warmus et al. discloses or suggests each of the elements recited by the claims at issue, it follows that such claims are not anticipated thereby. Further, none of the cited art discloses or suggests that it would be desirable or even possible to combine the features of one with features of one or more of the others to arrive at the subject matter recited by the independent claims at issue. In an obviousness inquiry, the motivation to combine prior art to solve a problem may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *Dyster Textilfarben GMBH v. C.H. Patrick Co.*, 2006 U.S. App. Lexis 24642 at *6 (Fed. Cir. 2006). Because none of the cited references suggest that it would be feasible to achieve the degree of variability contemplated by the claimed subject matter, there is simply no motivation to combine the features of the prior art to implement a book production apparatus or method as recited by claims 1-54. Therefore, it follows that the claimed subject matter is not rendered obvious by the cited art.

Further, because the dependent claims at issue incorporate the subject matter of the respective independent claims, it follows that the dependent claims are also allowable for the reasons presented above.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested.

Respectfully submitted,

McCracken & Frank LLP
200 W. Adams, Suite 2150
Chicago, Illinois 60606
(312) 263-4700

By: 
William E. McCracken
Reg. No: 30,195

October 13, 2006